Remarks

Claims 1-17 are pending.

Rejections under 35 USC § 103(a)

The Examiner rejects Claims 1-5, 10-12 and 14-16 as being unpatentable over U.S. Patent Application Publication No. 2002/0026337 (Sasaki) in view of "Hertz Corporation" (Hertz-I).

Sasaki shows a U.S. publication date of February 28, 2002, and a U.S. filing date of August 21, 2001. The present Application was filed on October 27, 2000, and, thus, Sasaki cannot be "prior art" as contemplated by Section 102 and/or Section 103(a).

The undersigned telephoned the Examiner to inquire about this point on May 13, 2003, and indicated that Sasaki was not "prior art" under Section 102(e). The Examiner stated that Sasaki might be prior art under Section 103(a) and further stated that he would look into this point. As of the present date, the undersigned has not heard back from the Examiner on this particular point.

It is respectfully submitted that Section 103(a) (dealing with the "differences between the subject matter sought to be patented and the 'prior art'") sheds no light on the question of whether a U.S. Patent Application Publication is prior art.

Although Sasaki is a printed publication as contemplated by Section 102(a), Sasaki's publication date of February 28, 2002 is after Applicants' filing date of October 27, 2000, thereby removing it as prior art under Section 102(a). Clearly, Sasaki is also not prior art under Section 102(b), which requires that the publication date be more than one year prior to the date of the application for patent.

Section 102(e)(1) deals with an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent. Although Sasaki purports to claim priority from a Japanese patent application filed on August 23, 2000, such Japanese patent application is clearly not a United States application for patent. Furthermore, even if Sasaki might issue as a U.S. patent, Section 102(e)(2) deals with a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent. Again, such Japanese patent application is clearly not a United States application for patent, and the U.S. filing date of Sasaki is after the filing date of the present Application.

Since there is no International (PCT) application involved, the Section 102(e) date of Sasaki is its U.S. filing date of August 21, 2001, which is after Applicants' filing date

of October 27, 2000. Hence, it is clear that Sasaki is also not prior art under Section 102(e). This conclusion is entirely consistent with the Office's own training materials:

> ***Don't EVER apply a reference based on a foreign priority filing date*** claimed under 35 USC §§ 119(a)-(d) or 365(a), ***in US ... application publications ... as the prior art date under § 102(e)***.
>
> * * *
>
> EX. A1B. PUBLICATION OF § 111(a) APPLICATION WITH § 120 BENEFIT CLAIM and § 119(a)-(d) PRIORITY CLAIM TO A FOREIGN APPLICATION
>
> ***... a foreign application filed in Japan on May 29, 1998; a first § 111(a) application filed on May 28, 1999, claiming § 119(a)-(d) priority to the Japanese application***; a second § 111(a) application filed on June 20, 2000 under 37 CFR 1.53(b) or (d) with § 120 priority claim to the earlier § 111(a) application; a third § 111(a) application filed on January 22, 2002 under 37 CFR 1.53(b) or (d) with § 120 priority claim to the earlier § 111(a) applications; and publication of the third § 111(a) application under § 122(b).
>
> ***US application publication § 102(e)(1) date: ...May 28, 1999***
> ***No benefit of the foreign application is given under § 102(e)(1).***
> (In re Hilmer, 149 USPQ 480 (CCPA 1966)).

http://www.uspto.gov/web/offices/dcom/olia/aipa/textpp102e.htm (35 USC §§ 102(e) and 374 as amended by HR 2215 (Technical Correction Act) (Text Version)) (***emphasis added***).

In view of the foregoing, it is respectfully submitted that Sasaki cannot be "prior art" to the present Application. Hence, it is respectfully submitted that the present rejection under Section 103(a) should be withdrawn.

Hertz-I is apparently not of record and is not cited on form PTO-892. During the undersigned's telephone conversation with the Examiner on May 13, 2003, the Examiner stated that Hertz-I may be found in another application. In the interest of completeness, the undersigned is attaching as Exhibit 1 the portions of Hertz-I (pages 1-61), which were apparently intended to be cited, made of record and considered by the Examiner.

Applicants traverse the citation of all of those pages by the Examiner, since it appears that the Examiner has improperly included Internet information dating from after Applicants' filing date.

> An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. §§ 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates.

See In re Wyer, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981).

However, the evidence of record does not show that certain portions of Hertz-I were publicly available and accessible as of the filing date of the present Application, namely, October 27, 2000.

> Date of Availability
>
> Prior art disclosures on the Internet or on an on-line database are considered to be publicly available ***as of the date the item was publicly posted.*** If the publication does not include a publication date (or retrieval date), it ***cannot be relied upon as prior art*** under 35 U.S.C. 102(a) or (b) .... Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication. See MPEP § 901.06(a), paragraph IV. G.

See MPEP 2128 (***emphasis added***).

Applicants traverse the incorporation of portions of Hertz-I (Exhibit 1), which clearly do not contain a date of public posting prior to Applicants' filing date. Those portions of Hertz-I include pages 37-52 and 54-61, which show a date of 2002, which date is clearly after Applicants' filing date. Applicants also traverse any inference that the Examiner might make that the present state of the Internet reflects the state of the Internet prior to October 27, 2000. Hence, it is requested that the Examiner include only pages 1-36 and 53 of Hertz-I (hereinafter, Hertz-II) in a new form PTO-892, in order that the record shows that the Examiner has cited, made of record and considered that particular reference.

In view of the above, and in the interest of the completeness of the record, Applicants respond to the present rejection in terms of only Hertz-II (*i.e.*, pages 1-36 and 53 of Hertz-I), which pages contain a date prior to Applicants' filing date. Furthermore, since Sasaki is not "prior art", that reference is not considered in the following remarks.

Hertz-II discloses that one can check the latest Hertz rates and instantly make, modify, or cancel reservations on-line. A credit card number is required to secure all reservations. If you're a Hertz #1 Club® or a Hertz #1 Club Gold® member you can use some or all of the information (including the credit card number) contained in your rental profile.

Claim 1 recites, *inter alia*, a method for completing and storing an electronic rental agreement comprising: entering reservation-related information and rental-related information for an item or service, the entering step entering: (a) the rental-related information without employing a master rental agreement, or (b) at least some of the rental-related information from a master rental agreement and allowing modification of the information from the master rental agreement for rental of the item or service without modifying the master rental agreement; providing a reservation for the item or service based at least in part upon the reservation-related information; creating and displaying a rental proposal based upon the reservation and the rental-related information; electronically accepting the rental proposal; and storing the electronic rental agreement based upon the accepted rental proposal.

Claim 1 recites entering reservation-related information and rental-related information for an item or service. Either (a) the rental-related information is entered without employing a master rental agreement, or (b) at least some of the rental-related information is entered from a master rental agreement and modification of the information is allowed from the master rental agreement for rental of the item or service without modifying the master rental agreement.

Hertz-II does not teach or suggest permitting a user to complete and store an ***electronic rental agreement*** for a vehicle ***without employing*** a master rental agreement. Hertz-II also does not teach or suggest entering some rental-related information from a master rental agreement and ***allowing modification of information*** from such master rental agreement ***without modifying*** such ***master rental agreement***. As set forth in the present specification at page 3, lines 10-13, in such circumstances, the user, such as a business traveler or a person on vacation, must complete a handwritten rental agreement at a rental counter, thereby wasting business or vacation time at the counter.

Hertz-II further does not teach or suggest creating and displaying a rental proposal based upon reservation and rental-related information; ***electronically accepting*** such rental proposal; and storing an ***electronic rental agreement based upon*** an ***accepted rental proposal***. Accordingly, for the above reasons, it is submitted that Claim 1 patentably distinguishes over the reference.

Claims 2-5, 10-12 and 14-16 depend directly or indirectly from Claim 1 and patentably distinguish over Hertz-II for the same reasons.

Claim 2 is not separately asserted to be patentable except in combination with Claim 1 from which it depends.

Claim 3 is not separately asserted to be patentable except in combination with Claims 1 and 2 from which it depends.

Furthermore, Claim 4 recites entering at least some of the rental-related information from a master rental agreement; and allowing modification of the information from the master rental agreement for rental of the item or service without modifying the master rental agreement. Hertz-II, which discloses that club members can use some or all of the information (including the credit card number) contained in a rental profile, does not teach or suggest the refined recital of entering at least some of rental-related information from a master rental agreement, and allowing modification of such information from such master rental agreement for rental of an item or service ***without modifying*** a ***master rental agreement***. Hence, it is submitted that Claim 4 further patentably distinguishes over the reference.

Claim 5 is not separately asserted to be patentable except in combination with Claims 1 and 4 from which it depends.

Furthermore, Claim 10, which depends from Claim 1 and includes all of the limitations thereof, recites sending a message to a database system responsive to the recited accepting step to indicate that a user has accepted the rental proposal. Since Hertz-II neither teaches or suggests the refined recital of Claim 1, it clearly neither teaches or suggests this additional recital, which further patentably distinguishes over the reference.

Claim 11 depends directly from Claim 10 and indirectly from Claim 1 and includes all of the limitations of Claims 10 and 11. Claim 1 makes clear that the rental proposal is electronically accepted, and that the electronic rental agreement is stored based upon an accepted rental proposal. Claim 11 further provides that a unique transaction is stored in the database system for the accepted rental proposal. Hertz-II (page 22), which discloses that there is a Hertz Confirmation number for a Hertz reservation, does not teach or suggest creating and displaying a rental proposal based upon reservation and rental-related information, electronically accepting such rental proposal, storing an electronic rental agreement based upon an accepted rental proposal, and storing a unique transaction in a database system for the recited accepted rental proposal within the context of Claims 1, 10 and 11. Hence, it is submitted that Claim 11 further patentably distinguishes over the reference.

Furthermore, Claim 12 recites storing a flag along with the unique transaction in the database system to indicate that the accepted rental proposal is electronically signed. Hertz-II, which discloses (page 34) that LDW (Loss Damage Waiver), if included in the

quoted rate, is included in a "Mandatory Items" or an "Inclusive Items" section, and, if not included, is listed within an "Optional Items" section, does not teach or suggest the refined recital of storing a flag along with a unique transaction in a database system to indicate that an accepted rental proposal is ***electronically signed***. As set forth in the present specification, at page 30, lines 12-20, the exemplary flags 656,658,660 are stored for future reference in order to confirm what rental options the customer has accepted and/or declined. The exemplary flag 654 is further stored for future reference in order to confirm that the user has electronically accepted (and "signed") the electronic "document" in order to confirm acceptance of the rental terms and conditions, in case that information is needed at a future date (*e.g.*, the customer was involved in a traffic accident with the selected rental vehicle and it, therefore, is necessary to determine whether or not the customer is eligible for one or both of the exemplary CDW and EP insurance coverages). Hence, it is submitted that Claim 12 further patentably distinguishes over the reference.

Claim 14 is not separately asserted to be patentable except in combination with Claim 1 from which it depends.

Claim 15 is not separately asserted to be patentable except in combination with Claims 1 and 14 from which it depends.

Furthermore, Claim 16 recites electronically accepting the rental proposal at a client system. Since Hertz-II neither teaches or suggests the refined recital of Claim 1, it clearly neither teaches or suggests this additional recital, which further distinguishes over the reference.

The Examiner rejects Claims 6-9 as being unpatentable over Sasaki in view of Hertz-I and further in view of U.S. Patent No. 5,389,773 (Coutts et al.).

As was discussed above, in the interest of the completeness of the record, Applicants respond to the present rejection in terms of only Coutts et al. and Hertz-II (*i.e.*, pages 1-36 and 53 of Hertz-I), which pages contain a date prior to Applicants' filing date. Furthermore, since Sasaki is not "prior art", that reference is not considered in the following remarks.

Coutts et al. discloses a self-service system, such as an automated teller machine (ATM) system, using predictive technology. When a user begins a transaction by inserting an identification card into a card reader of an ATM, the predictive technology predicts which service or services provided by the system the user is likely to request. This prediction is based upon a stored record in the system, representing previous transactions by

that user. The prediction is made in advance of completion of an authorization process for the transaction, to increase the speed of operation of the ATM in carrying out the transaction.

Coutts et al., which discloses an automated teller machine system, has nothing to do with any electronic rental agreement, reservation-related information or rental-related information, and adds nothing to Hertz-II to render Claim 1 unpatentable.

Claims 6-9 depend directly or indirectly from Claim 1 and patentably distinguish over Hertz-II and Coutts et al. for the same reasons.

Furthermore, Claim 6 recites maintaining a history of rental information for prior rentals by a user, entering information from an identification of a user, and entering at least some of the rental-related information from the history based upon the information from an identification of a user without employing a master rental agreement. Coutts et al., which has nothing to do with any rental agreement or any rental-related information, does not teach or suggest maintaining a history of ***rental*** information for prior ***rentals*** by a user, entering information from an identification of a user, and entering at least some of ***rental***-related information from such history based upon such information from an identification of a user without employing a ***master rental agreement***. Therefore, it is submitted that Claim 6 further patentably distinguishes over the references.

Claim 7 is not separately asserted to be patentable except in combination with Claims 1 and 6 from which it depends.

Claim 8, which depends from Claim 6, further recites provisionally entering at least some of the recited rental-related information from the history. Since the references neither teach or suggest the refined recital of Claims 1 and 6, they clearly neither teach or suggest this additional recital, which further patentably distinguishes over the references.

Furthermore, Claim 9 recites modifying at least some of the provisionally entered at least some of the rental-related information from the history. Since the references neither teach or suggest the refined recital of Claims 1, 6 and 8, they clearly neither teach or suggest this additional recital, which further patentably distinguishes over the references.

The Examiner rejects Claims 13 and 17 as being unpatentable over Sasaki in view of Hertz-I and further in view of an article (Reference U of form PTO-892) (kioskcom.com).

As was discussed above, in the interest of the completeness of the record, Applicants respond to the present rejection in terms of only kioskcom.com and Hertz-II (*i.e.*, pages 1-36 and 53 of Hertz-I), which pages contain a date prior to Applicants' filing date.

Furthermore, since Sasaki is not "prior art", that reference is not considered in the following remarks.

The reference kioskcom.com discloses that a "DOLLAR® TRAVEL CENTER" is an interactive kiosk providing helpful travel information for its customers at various airports. The kiosks are conveniently located at the DOLLAR pickup and return areas at each airport. By touch, customers can make air, hotel and DOLLAR car rental reservations; obtain U.S. weather forecasts, driving directions and event information; access personal Web-based e-mail accounts, as well as receive free Internet access and view the top headline news of the day, all at the interactive kiosk.

This reference kioskcom.com, which discloses airport kiosks to make air, hotel and car rental reservations, adds nothing to Hertz-II to render Claims 1 and/or 12 unpatentable.

Claims 13 and 17 depend directly or indirectly from Claim 1 and patentably distinguish over Hertz-II and kioskcom.com for the same reasons.

Claim 13 depends directly from Claim 12 and indirectly from Claims 1, 10 and 11, includes all of the limitations of those claims, and provides employing the recited stored flag to enable allocation of an item or service at a kiosk. That stored flag indicates that the recited accepted rental proposal is ***electronically signed***. The reference kioskcom.com, which discloses airport kiosks to make air, hotel and car rental reservations, does not teach or suggest employing any stored flag, which indicates that an accepted rental proposal was electronically signed, to enable allocation of an item or service at a kiosk. Accordingly, it is submitted that Claim 13 further patentably distinguishes over the references.

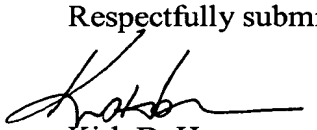
Claim 17 is not separately asserted to be patentable except in combination with Claim 1 from which it depends.

Summary and Conclusion

The prior art made of record and not relied upon but considered pertinent to Applicants' disclosure has been reviewed. In summary, it is submitted that the claims are allowable over the references of record.

Reconsideration and early allowance are respectfully requested.

Respectfully submitted,



Kirk D. Houser
Registration No. 37,357
Attorney for Applicants

(412) 566-6083